UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,331	07/01/2004	David S Bonalle	70655.2900	4330

20322	7590	11/29/2005	EXAMINER

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ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 August 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2 and 4-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1, 2, and 4-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Receipt is acknowledged of the Amendment received on 29 August 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2.   Claims 1-2 and 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Black, as cited in the previous Office Action, in view of de Sylva (US 2005/0098621).

        Re claim 1, Black teaches a biometric sensor to detect a proffered biometric sample a

device configured to associate the proffered biometric sample with user information and

smartcard information to create a data packet, wherein the sample is associated with an account

including at least one of a charge account, credit card account, debit card account, savings

account, private label account, PayPal account, membership account, Western Union Account, electronic bill payment account, automatic bill payment account, and loyalty account, and a storing a data packet either locally or remotely (FIG. 1A, 1C, abstract, 5A, 10A-11B, 14A-14B, paragraph [0090]+, and paragraph [0014]+). The Examiner has interpreted the information and biometric to constitute a data packet. As Black teaches the information can be stored remotely or locally, the examiner notes it would have been obvious to store the information in a database, since a database is well known and conventional in the art to conveniently storing and organizing data for easy access. As the information (data packet) is part of the authentication/registration process, it would obviously communicate with the system as part of the process.

Black is silent to the biometric sample being associated with at least two accounts.

De Sylva teaches that one biometric sample is required and that one sample is associated with different accounts based on a relationship established by the user record (30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of de Sylva.

One would have been motivated to do this in order to have only one sample required for access, thus still maintaining security, but allowing a user to establish a relationship for multiple account usage (convenience/personalization).

Re claim 2, the Examiner notes that Black teaches that the biometric is stored either on the smartcard/transponder or remotely. Accordingly, it would have been obvious to store, process, and verify the sample as part of the process to associate and authenticate/verify the sample, as is conventional in the art.

Re claim 4, it has been discussed above that users accounts and biometrics are associated. The Examiner notes that it is obvious that different biometric samples (from different users) can be associated with different accounts. It would have been obvious to do this in order to have ea system that many different people can use. As different people have different samples and accounts, it would have been obvious that each sample is associated with a different account in order to have a secure system.

Re claim 5, it has been discussed above that the data packet can be stored on a database. The Examiner notes that Black teaches that the stored information includes at least one of a sample, user information, terrorist information, and criminal information (FIG. 10A+ and FIG. 14A+ which teach user records). The storing of such information o a database is an obvious expedient to facilitate organizing and efficient data storage.

Re claim 6, it has been discussed above that the data packet can be stored locally or remotely. Accordingly, it would have been obvious to one of ordinary skill in the art that remote/local storing would include one of a remote server, merchant server, smartcard system, smartcard reader, sensor, and smartcard itself. One would have been motivated to store it accordingly, based on desired security concerns.

Re claim 7, when stored remotely, the Examiner notes it would have been obvious that the database be operated by an authorized sample receiver, in order to ensure security.

Re claim 8, the limitations have been discussed above, where de Sylva teaches primarily and secondarily associating different information with a sample based on user preferences. The Examiner notes it would have been obvious for the associating device to perform such a task, in order to process and store the data that is being provided to it.

Re claim 9, the limitations have been discussed above re claim 8.

Re claim 10 and 11, as discussed above, it would have been obvious to one of ordinary skill in the art to associate different samples with different information in instances where there are multiple users of the system, for unique identification. The use of many samples has been discussed above, as well.

Re claim 12, the Examiner notes that secondary security procedures to facilitate verification of a proffered sample are well known and conventional in the art (in order to determine that a sample is a real sample, for example). One would have been motivated to verify the sample, in order to ensure that it is real (security reasons). It would have been obvious for the device that associates the information to perform the procedure, as part of the process to register samples and user information.

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]). It is obvious that the device that associates would perform such steps, as they are integral to the process of registering and storing data.

Re claim 14, it has been discussed above that a fingerprint sample is obtained. It would have been obvious that a fingerprint be scanned, it order to obtain the fingerprint data to facilitate authentication/registration.

Re claim 15, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

Re claim 16, the accounts discussed above are interpreted as unassociated.

Re claim 17, the Examiner notes that it has been discussed above that selection of accounts is made based along criteria set forth. Accordingly, it would have been obvious to have a device facilitate selection of the account, in accordance with the rules, in order for charges to automatically be made to comply with the rules (processor, controller, etc).

Response to Arguments

3.   Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Machida (US 2004/0131237) and Royer et al. (US 2004/0155101).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
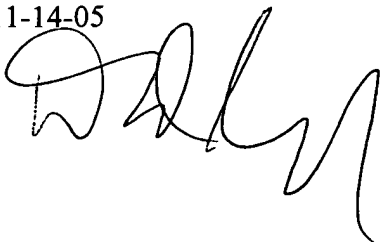
MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The

examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
11-14-05

KARL D. FRECH
PRIMARY EXAMIN'